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10/766,489	01/29/2004	Hiroyuki Ohnuma	31759-200511	3736
26694	7590	07/12/2006	EXAMINER	
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998				ADAMS, CHARLES D
			ART UNIT	PAPER NUMBER
			2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/766,489	OHNUMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Charles D. Adams	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 January 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1-29-04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 and 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-5, 7-9, 13-15, and 17-19 contain the terms "the one document" and "the other one document". The use of such terminology is confusing and unclear. Examiner suggests phraseology of the following form: "a first document", "a second document", etc., to more clearly differentiate documents, as opposed to the terms "a one document" and "an other one document", which could be read as being the same document.

Claims 1 and 11 recite the limitation "the weight value" in line 5, "the relevance concerned" in line 6, and "the calculation processing" in line 8. There is insufficient antecedent basis for these limitations in the claim.

Claims 2 and 12 recite the limitation "the existing location of said each document" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 3 and 13 recite the limitation "the other one document" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 4 and 14 recite the limitation "the other one document" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 5 and 15 recite the limitation “the other one document” in line 2, and “the different trees” in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claims 6 and 16 recite the limitation “the reference relation” in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 7 and 17 recite the limitation “the other one document” in line 3, and “the third document” in line 4. There is insufficient antecedent basis for these limitations in the claim.

Claims 8 and 18 recite the limitation “the other one document” in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 3-5, 7-9, 13-15, and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “the one document concerned” and “the other one document concerned” is unclear. The application has been examined as if such phrases were simply meant to read “the one document” and “the other document”, as ‘concerned’ was interpreted to refer back to the initial recitation of “the one document” and “the other one document”.

Claims 5, 9, 15, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims contain subject matter that is optionally recited. As such, the claims bear no patentable weight. See MPEP § 2106 Section II(C):

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. >See also MPEP § 2111.04.<

Claims 9 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is unclear because there is a test as to whether or not "one document" is referring to something that is also named "one document". Examiner has read this claim to be a test as to whether or not a document has any other documents referring to it. In addition to this, the claim ends with the limitation "the one document concerned", while it is unclear exactly which of the previous recitations of "one document" this limitation is referring to.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a useful, concrete, and tangible result. To be useful the claimed invention must establish a specific, substantial, and credible utility. In this case the claims fail to perform a useful result because no result is claimed of the relevance calculations.

Claims 11-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a useful, concrete and tangible result. To perform a physical transformation, the claimed invention must transform an article of physical object into a different state or thing. Transformation of data is not a physical transformation. To be tangible the claimed invention must produce a practical application or real world result.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 5-12, and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang (US Pre-Grant Publication 2003/0101415).

As to claim 1, Chang teaches an evaluation apparatus of named entities giving an evaluation value to named entities included in a document (see Abstract) comprising:

A document weight calculation section which defines a mutual relevance among a plurality of documents including the named entities as an object to be given the evaluation value, and calculating the weight value of said each document based on the relevance concerned (see paragraphs [0065]-[0066] and [0093]); and

An evaluation value calculation section calculating the evaluation value of said named entities by carrying out the calculation processing using the weight value of said each document (see paragraphs [0095]-[0097]).

As to claim 2, Chang teaches wherein said plurality of documents is managed under a tree structure, and said document weight calculation section defines said relevance between respective documents corresponding to the existing location of said each document in said tree structure (see paragraphs [0063]-[0066] and [0093], and Figures 3 and 6).

As to claim 5, Chang teaches wherein if one document and the other one document are managed under the different trees, said document weight calculation section maximizes or minimizes the weight value of the one document concerned and the other one document concerned (see paragraphs [0070]-[0071], [0089], and [0093]. The root of the tree is maximized, so if there exists another tree that another set of documents is managed under, its weight will be maximized).

As to claim 6, Chang teaches wherein said document weight calculation section defines the relevance between respective documents corresponding to the reference relation between said respective documents (see paragraphs [0093] and Figure 6. The relevance of a document compared to other documents is defined based on the depth of a document, which is based on interconnections with other documents).

As to claim 7, Chang teaches wherein said document weight calculation section increases or decreases the weight value of one document and the other one document corresponding to whether or not there exists the third document which directly or indirectly refers to both of the one document concerned and the other one document concerned (see paragraph [0093] and Figure 6. The weight is increased or decreased depending on how deep a document is. For example, if there is a third document that refers to the two documents from above, then their weights will be decreased as they are deeper in the tree).

As to claim 8, Chang teaches wherein said document weight calculation section increases or decrease the weight value of one document and the other one document corresponding to whether or not the one document concerned directly or indirectly refers to the other one document concerned (see paragraph [0093] and Figure 6. If a document is directly or indirectly referred to by a document above it in the tree structure, its weight will be less than that document).

As to claim 9, Chang teaches wherein if there is no other one document referring to one document, said document weight calculation section maximizes or minimizes the weight value of the one document concerned (see paragraph [0093] and Figure 6. The top of a tree has its weight maximized).

As to claim 10, Chang teaches further comprising a document collection section collecting said plurality of document (see paragraphs [0061]-[0062] and [0103]-[0105]); and

A document relevance storage section storing the mutual relevance of the documents collected by said document collection section (see paragraphs [0061]-[0062] and [0098]-[0101]).

As to claim 11, Chang teaches an evaluation method of named entities giving an evaluation value to named entities included in a document (see Abstract) comprising:

A document weight calculation process defining a mutual relevance among a plurality of documents including the named entities as an object to be given the evaluation value and calculating the weight value of said each document based on the relevance concerned (see paragraphs [0065]-[0066] and [0093]); and

An evaluation value calculation process calculating the evaluation value of said named entities by carrying out the calculation processing using the weight value of said each document (see paragraphs [0095]-[0097]).

As to claim 12, Chang teaches wherein said plurality of documents is managed under a tree structure, and in said document weight calculation process, the relevance between said respective documents is defined corresponding to the existing location of said each document in said tree structure (see paragraphs [0062]-[0066] and [0093] and Figures 3 and 6).

As to claim 15, Chang teaches wherein if one document and the other one document are managed under the different trees, the weight value of the one document concerned and the other document concerned is maximized or minimized (see paragraphs [0070]-[0071], [0089], and [0091]).

As to claim 16, Chang teaches wherein in the document weight calculation process, the relevance between respective documents is defined corresponding to the reference relation between said respective documents (see paragraph [0093]).

As to claim 17, Chang teaches wherein the weight value of one document and the other one document is increased or decreased corresponding to whether or not there exists the third document which directly or indirectly refers to both of the one document concerned and the other one document concerned (see paragraph [0093] and Figure 6).

As to claim 18, Chang teaches wherein the weight value of one document and the other one document is increased or decreased corresponding to whether or not the one document concerned directly or indirectly refers to the other one document concerned (see paragraph [0093] and Figure 6).

As to claim 19, Chang teaches wherein if there is no other one document referring to one document, the weight value of the one document concerned becomes maximum or minimum (see paragraph [0093] and Figure 6).

As to claim 20, Chang teaches further comprising a document collection process collecting said plurality of document (see paragraphs [0061]-[0062] and [0103]-[0105]); and

a document relevance storage process storing the mutual relevance of the documents collected in said document collection process (see paragraphs [0061]-[0062] and [0098]-[0101]),

wherein said document collection process and said document relevance storage process are carried out at least before said document weight calculation process (see paragraph [0062] and [0076]. The calculation of weights is done after the pages are created)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4 and 13-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US Pre-Grant Publication 2003/0101415) in view of Dean et al. (US Patent 6,138,113).

As to claim 3, Chang teaches an evaluation apparatus as claimed in claim 2.

Chang does not teach wherein said document weight calculation section increases or decreases the weight value of one document and the other one document corresponding to the number of nodes of the tree structure common to the one document concerned and the other one document concerned.

Dean et al. teaches wherein said document weight calculation section increases or decreases the weight value of one document and the other one document corresponding to the number of nodes of the tree structure common to the one

document concerned and the other one document concerned (see column 3, lines 31-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Chang by the teaching of Dean et al. since Dean et al. teaches "an improved ranking method that can be implemented as part of a search engine. Alternatively, our method can be implemented by one of the clients as part of the Web browser. Our method uses content analysis, as well as connectivity analysis, to improve the ranking of pages in the result set so that just pages related to a particular topic are identified" (see 3:6-12).

As to claim 4, Chang teaches an evaluation apparatus as claimed in claim 2. Chang does not teach wherein said document weight calculation section increases or decreases the weight value of one document and the other one document corresponding to the number of branches of the tree structure existing between the one document concerned and the other one document concerned.

Dean et al. teaches wherein said document weight calculation section increases or decreases the weight value of one document and the other one document corresponding to the number of branches of the tree structure existing between the one document concerned and the other one document concerned (see 3:21-25 and 4:65-5:6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Chang by the teaching of Dean et al.

since Dean et al. teaches "an improved ranking method that can be implemented as part of a search engine. Alternatively, our method can be implemented by one of the clients as part of the Web browser. Our method uses content analysis, as well as connectivity analysis, to improve the ranking of pages in the result set so that just pages related to a particular topic are identified" (see 3:6-12).

As to claim 13, Chang teaches an evaluation method as claimed in claim 12.

Chang does not teach wherein the weight value of one document and the other one document is increased or decreased corresponding to the number of nodes of the tree structure common to the one document concerned and the other one document concerned.

Dean et al. teaches wherein the weight value of one document and the other one document is increased or decreased corresponding to the number of nodes of the tree structure common to the one document concerned and the other one document concerned (see column 3, lines 31-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Chang by the teaching of Dean et al. since Dean et al. teaches "an improved ranking method that can be implemented as part of a search engine. Alternatively, our method can be implemented by one of the clients as part of the Web browser. Our method uses content analysis, as well as connectivity analysis, to improve the ranking of pages in the result set so that just pages related to a particular topic are identified" (see 3:6-12).

As to claim 14, Chang teaches an evaluation method claimed in claim 12.

Chang does not teach wherein the weight value of one document and the other one document is increased or decreased corresponding to the number of branches of the tree structure existing between the one document concerned and the other one document concerned.

Dean et al. teaches wherein the weight value of one document and the other one document is increased or decreased corresponding to the number of branches of the tree structure existing between the one document concerned and the other one document concerned (see 3:21-25 and 4:65-5:6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Chang by the teaching of Dean et al. since Dean et al. teaches "an improved ranking method that can be implemented as part of a search engine. Alternatively, our method can be implemented by one of the clients as part of the Web browser. Our method uses content analysis, as well as connectivity analysis, to improve the ranking of pages in the result set so that just pages related to a particular topic are identified" (see 3:6-12).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Adams whose telephone number is (571) 272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles Adams  
AU 2164



SAM RIMELL  
PRIMARY EXAMINER